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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,772	02/06/2004	Martin Michaelis	DEA V2003/0008 US NP	7891

5487 7590 04/24/2006

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EXAMINER

CORDERO GARCIA, MARCELA M

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/773,772	Applicant(s) MICHAELIS ET AL.	
	Examiner Marcela M. Cordero Garcia	Art Unit 1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the reply received on April 15, 2005.

Claims 1-5 and 7 are pending in the application.

Any rejection from the previous office action, which is not restated here, is withdrawn.

Applicant's election with traverse of the species D-arginyl-L-arginyl-L-prolyl-L-prolylglycyl-3-(2-thienyl)-L-alanyl-L-seryl-(3R)-1,2,3,4-tetrahydro-3-isoquinolinecarbonyl-(2S,3aS,7aS)-octahydro-1H-indole-2-carbonyl-L-arginine [i.e., D-Arg-L-Arg-L-Pro-L-Pro-Gly-Thia-L-Ala-L-Ser-(3R)-1,2,3,4-tetrahydro-3-isoquinolinecarbonyl-(2S,3aS,7aS)-octahydro-1H-indole-2-carbonyl-L-Arg] , in the reply filed on September 12, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Please note the following abbreviations and their corresponding equivalents:

Thia = 2-thienylalanyl; Tic = 1,2,3,4-tetrahydroisoquinolin-3-yl carbonyl, and

Oic = octahydro-1H-indole-2-carbonyl.

Claims 1-5 and 7 are presented for examination on the merits as they read upon the elected species.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as obvious over Henke et al. (US 5,648,333, cited in IDS of 02/04) in view of Pavelka (Eur J Pain, 2000, abstract), in view of McCormack et al. (WJM 1996) and in view of Haapala et al. (Clin Orthop 1999)

Henke et al. teach a method for treating arthritis and treating pain in a patient in need thereof comprising administering to the patient a pharmaceutically effective amount of a composition comprising a compound of formula I, wherein the compound is H-(D)-Arg-Arg-Pro-Pro-Gly-Thia-Ser-(D)-Tic-Oic-Arg-OH. (See, e.g., Example 60 and column 17, lines 10-18 and 25-67). See also, e.g., claims 1, 12, and especially 27-28 and 30).

Henke et al. do not expressly teach treating the specific type of arthritis known as osteoarthritis, or treating spondyloses or treating cartilage atrophy.

Pavelka teaches that osteoarthritis causes pain. (See, e.g., abstract)

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McCormack et al. teach that spondyloses causes pain. (See, e.g., abstract)

Haapala et al. teach that lengthy immobilization causes cartilage atrophy in dogs and may jeopardize the "well being" of articular cartilage (See, e.g., abstract) which intrinsically reads upon causing pain (See, e.g., abstract, and column 1, page 218 and page 227).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify method of Henke by treating pain related with osteoarthritis, spondyloses or cartilage atrophy as taught by Pavelka, McCormack et al. and Haapala. The skilled artisan would have been motivated to do so because Henke et al. teach treating pain with H-(D)-Arg-Arg-Pro-Pro-Gly-Thia-Ser-(D)-Tic-Oic-Arg-OH. There would have been a reasonable expectation of success, given that osteoarthritis, spondyloses and cartilage atrophy cause pain as taught by Pavelka, McCormack et al. and Haapala. Thus the invention as a whole was clearly prima facie obvious to one of ordinary skill in the art at the time the invention was made.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 and 7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27-28 and 30 of U.S. Patent No. 5,648,333 (cited in IDS of 02/04) in view of Pavelka (Eur J Pain, 2000, abstract), in view of McCormack et al. (WJM 1996) and in view of Haapala et al. (Clin Orthop 1999)

Henke et al. Pavelka, McCormack et al. and Haapala et al. teach a method of treating a degenerative joint disease in a patient in need thereof wherein said degenerative joint disease is selected from the group consisting of osteoarthritis, spondyloses and cartilage atrophy, wherein said method comprises administering to the patient a pharmaceutically effective amount of a compound of formula I -(D)-Arg-Arg-Pro-Pro-Gly-Thia-Ser-(D)-Tic-Oic-Arg-OH (as discussed above).

Further, the instantly claimed method encompasses and/or is encompassed by the claimed method of US 5,648,333.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcela M. Cordero Garcia whose telephone number is (571) 272-2939. The examiner can normally be reached on M-Th 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Marcela M Cordero Garcia, Ph.D.
Patent Examiner
Art Unit 1654

MMCG 04/06



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